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10/049,331

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EXAMINER

FERTIG, BRIAN E

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/049,331 | Applicant(s) WIECZOREK, FRANK | |
| | Examiner BRIAN FERTIG | Art Unit 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examination Note

1. Examiner observes that Applicant has claimed many features of the matrix with at least 4 dimensions in terms of non-functional descriptive material (i.e. elements in various lists). Non-functional descriptive material is only given patentable weight when a new and unobvious functional relationship between the printed matter and the substrate (see MPEP § 2106.01 for further discussion). In the present invention, the elements (printed matter) are related to the substrate (lists) as options to be chosen from those lists. In view of the list boxes and other configuration tools taught by Lewis (see col 18, lines 10-53), such functional relationship is neither new nor unobvious. As such, the non-functional material has been considered, but has not been granted patentable weight so as to distinguish Applicant's invention from the prior art.

Claim Objections

2. Claim 21-30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As discussed above, these claims attempt to limit the parent claims by reciting non-functional descriptive material. This material has been considered, but not afforded patentable weight so as to distinguish Applicant's invention from the prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18 and 21-25 recite limitations in terms of 'can be.' Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see MPEP § 2106 for further discussion). Claims 19, 20, and 26-31 are rejected for incorporating the subject matter rejected above.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 18-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims recite a system having various components, including a matrix with at least 4 dimensions. A matrix is an Abstract idea which has been identified by the courts as Judicial Exception to statutory subject matter. When an invention includes a Judicial Exception, it may be none the less statutory if the claims transform physical matter or produce a useful, tangible, and concrete result, thus yielding a practical application of the abstract idea (see MPEP § 2106 for further discussion)

The present invention fails to transform physical matter as it operates entirely on data. It also fails to create a concrete result. The claims directed to the matrix with at least 4 dimensions leave silent the construction of the 4 dimensions. As such, defining these dimensions is left to the individual implementing the invention. As such, the implementer must use human judgment in the process of constructing the claimed system. Human judgment varies from person to person, thus yielding a different system when practiced by different implementers. As such, Applicant's invention, as claimed, fails to produce a concrete result and is therefore directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 18-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,233,565 to Lewis (Lewis).

With respect to claim 18

Lewis teaches:

A system for supporting a communication to operate a trading center comprising:

at least one first workstation on a side of an operator (i.e. transaction server, see col 8, lines 8-37 and fig 2); and

a plurality of second workstations with access to the internet on a side of an initiator (i.e. customer, see col 8, lines 8-37 and fig 2),

wherein at the first workstation, a matrix with at least four dimensions can be generated and can be transmitted from there (i.e. transaction request, see col 8, lines 8-37 and col 14, lines 26-42, note that the transaction server sends purchase and refund requests, see also table I indicating 4 or more dimensions)

wherein each dimension includes at least one selection list, the selection list comprising:

at least a first initiator list (non-functional descriptive material – see discussion above),

a second market segment list (non-functional descriptive material – see discussion above),

a third product list (non-functional descriptive material – see discussion above), and

a fourth trading scenario list (non-functional descriptive material – see discussion above), and

wherein each selection list comprises a number of elements, which can be individually marked for selection or unselection (see col 18, lines

10-52, note that printers, logging, cleansing, addresses, etc can be marked for selection or unselection),

wherein each marking of one of the elements can be stored and recalled (see col 18, lines 10-52, note the teaching of defaults suggesting that elements can be stored and recalled, for example, so that they may be edited and the defaults changed),

wherein the matrix can be called and processed at each of the second workstations (see col 18, lines 10-52, note that the user performs the changes in setting, implicitly using the customer workstation pictured in fig 2), and

wherein the processed matrix can be sent from each of the second workstations (see col 18, lines 10-52, note that the data is stored on the server, implicitly it was sent to the sever from the second workstation where it was edited to the server), and

wherein the sent and processed matrix can be processed at the first workstation (see col 18, lines 10-52, note that the data is stored on the server).

With respect to claim 19

Lewis teaches:

The system according to claim 18 (see rejection of claim 18 above), further comprising:

a server (i.e. transaction server, see col 8, lines 8-37 and fig 2);

a firewall (i.e. firewall, see col 8, lines 8-37 and fig 2) ; and
a router (i.e. outbound router, see col 8, lines 8-37 and fig 2)
wherein the server, the firewall, and the router are between the first
workstation and the second workstation, and wherein a dedicated line (i.e.
unique ip address/port) and a web server (i.e. web server) are arranged
between the router and the second workstation (see col 8, lines 8-37 and
fig 2).

With respect to claim 20

Lewis teaches:

The system according to claim 18 or 19 (see rejections of claim 18 or 19 above),
wherein each element is scalable (see col 11, lines 1-5).

With respect to claims 21-30

These claims contain limitations directed to non-functional descriptive material. This
material has been considered, but not afforded patentable weight so as to distinguish
Applicant's invention from the prior art. As such, they are rejected in view of Lewis.

With respect to claim 31

Lewis teaches:

The system according to claim 18 (see rejection of claim 18 above), wherein the
operator is an internet platform operator or a service provider (note that the
platform is available via the internet, see fig 2)

Allowable Subject Matter

9. While no allowable subject matter is recited in Applicant's current claims, Examiner respectfully notes that Applicant's invention seems largely directed to the structure of the matrix of at least 4 dimensions. Examiner directs Applicant to MPEP § 2106.01 giving the definition of a 'data structure' and notes that a properly embodied data structure is patent eligible. Examiner also notes that the inventive features must be in the relationships between the data elements and not the data elements themselves. This observation is meant as a guide only and should not be construed to convey allowability of any subject matter.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3694

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/
Primary Examiner, Art Unit 3694